

REMARKS/ARGUMENTS

Claims 1-18, 21-30, 38-42, 47-53, and 55-59 are currently pending. Applicants elect not to amend the claims.

Claims 58-59 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Claims 1-5, 9-10, 16-17, 26-28, 49-53 and 55-59 are rejected under 35 U.S.C. § 103(a) as being unpatentable over by Daniels (U.S. Patent No. 6,417,840 B1) in view of Stork et al. (U.S. Patent No. 6,275,174) and Kim (U.S. Patent No. 6,545,664).

Claims 6 and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over by Daniels in view of Stork '174, Kim, and Liu (U.S. Patent No. 6,133,907).

Claims 8, 11-15, 18, and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniels in view of Stork '174, Kim, and Stork (U.S. Patent No. 6,181,329).

Claims 22-25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniels in view of Stork '174, Kim, and Hu (U.S. Patent No. 5,952,997).

Claims 29-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniels in view of Stork '174, Kim, and Buchner et al. (U.S. Patent No. 5,532,753).

Claims 38-42 and 48 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniels in view of Kim.

Claim 47 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniels, in view of Kim, and Liu.

Claim 49-53 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniels.

Applicants respectfully traverse the rejection of claims 58-59 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. MPEP § 2164 clearly establishes that merely because the exact claim language of a claim is not in the specification of an application, this in and of itself does not establish prima facie lack of enablement. A claim in and of itself may be enabling if no undue experimentation is required for

one of skill in the art to make and use the invention. Applicants submit that making a switch for substantially simultaneous operation of two modes of a circuit is well within the skill of one in the art. This does not imply, however, in any way that the use of such a switch in the instant invention is obvious, but merely that the manufacture of such a switch is well within the skill of one in the art. As the manufacture of such a switch is well within the skill of one of skill in the art, the claims in and of themselves are enabling. Therefore, Applicants respectfully request that this rejection be withdrawn.

Applicants respectfully submit that each of independent claims 1, 16, and 49 is not rendered obvious by Daniels in view of Stork '174 and Kim as the Examiner has not established a prima facie case of obvious. Applicants respectfully submit that independent claim 38 is not rendered obvious by Daniels in view of Kim as the Examiner has not established a prima facie case of obvious.

Specifically, the Examiner has not established that Kim is prior art against the instant application. The filing date of Kim is September 29, 2000, which is after the filing date of the instant application, which is August 2, 2000. Kim is a **continuation-in-part application** of U.S. Patent Application No. 09/157,030, filed September 18, 1998. To establish that Kim is prior art against the instant application the Examiner must establish that the disclosure in U.S. Patent Application No. 09/157,030 supports the claims of Kim as issued. See MPEP § 2136.03 (IV). The Examiner has failed to establish that the claims as issued in Kim are supported by U.S. Patent Application No. 09/157,030. Therefore, Kim is not prior art to the instant application. Therefore, each and every rejection that cites Kim is moot.

Daniels fails to render claim 49 obvious as Daniels fails to show or suggest every limitation of claim 49. Specifically, Daniels fails to show or suggest “**combining** a first portion of the device with a second portion of the device **to contact** a first electrical contact in the first portion to a second electrical contact in the second portion,” as recited in claim 49. Daniels discusses the use of a switch 83 to make an electrical contact. See FIG. 11 of Daniels. The switch does not make contact as a result of **combining portions of a device**. The switch of Daniels merely makes electrical contact between a first contact 81 or a second contact 83 as a

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result of being switched, not as a result of portion of a device being combined. As the Daniels switch does not make contact as the result of a combining operation of two different portion of a device, Daniels fails to show or suggest every limitation of claim 49. Therefore, Daniels fails to render claim 49 obvious.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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